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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,591	09/24/2003	Doug Duchon	57173/1481	5690

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Kramer Levin Naftalis & Frankel LLP
919 Third Avenue
New York, NY 10022

EXAMINER

HUH, BENJAMIN

ART UNIT	PAPER NUMBER
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3767

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/669,591	Applicant(s) DUCHON ET AL.	
	Examiner Benjamin Huh	Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/11/06 has been entered.

Priority

The disclosure of the prior-filed application, Application No. 08/946293, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The claims of the instant application are not supported by the continuation in part of Application No. 08/946293 and therefore only obtain priority data back to the application of 08/957801 with a priority date of 10/24/1997.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-30 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the act of providing the fluid required for the refilling procedure, otherwise the device could be retracting the plunger to just provide air. Also, retracting the plunger while receiving more fluid for the subsequent rejection. Last, the communication of the fluid for refilling with the syringe.

Claim Objections

Claims 23 & 27 are objected to because of the following informalities: the claims state the use of a "predetermined limit" it is requested that the applicant clarify the term by utilizing the predetermined limit to correspond to either the amount needed for having the preset amount of fluid or as seen appropriate. Appropriate correction is required.

Claims 23 & 27 are objected to because of the following informalities: the newly inserted line "receiving a preset amount of fluid necessary for a subsequent injection from user input" can be read multiple ways, the first being that the step is physically receiving a preset amount of fluid from the user, the second being the step of data being input into the device to determine a preset amount of fluid necessary for the subsequent injection. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23-25 & 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Rosenberg et al (Us Patent No. 4596575). Rosenberg et al discloses an injection device which automatically refills a syringe, the method comprising sensing a volume of fluid in a chamber of the syringe, receiving a preset amount of fluid necessary for a subsequent injection from user input, wherein this step the preset amount of fluid is seen to be an actual amount of fluid from a separate source being provided from a user therefore user input; comparing said volume in said chamber with said preset amount of fluid and retracting a plunger within said chamber of said syringe to a predetermined limit if said preset amount of fluid is greater than the volume of fluid sensed in said chamber, wherein predetermined limit maximally fills said chamber of said syringe, wherein the predetermined limit is less than a maximal volume of said chamber, see col. 1 line 60 – col. 2 line 5, col. 2 line 66 – col. 3 line 7, col. 5 line 65 – col. 6 line 17.

Claims 23-25 & 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Rubinstein (US Patent No. 3888239). Rubinstein discloses an injection device which automatically refills a syringe, the method comprising sensing a volume of fluid in a chamber of the syringe, receiving a preset amount of fluid necessary for a subsequent injection from user input, wherein this step the preset amount of fluid is seen to be an actual amount of fluid from a separate source being provided from a user therefore user

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input;; comparing said volume in said chamber with said preset amount of fluid and retracting a plunger within said chamber of said syringe to a predetermined limit if said preset amount of fluid is greater than the volume of fluid sensed in said chamber, wherein predetermined limit maximally fills said chamber of said syringe, wherein the predetermined limit is less than a maximal volume of said chamber, see col. 2 line 57 – col. 3 line 7 and col. 6 line 5 – 59.

Claims 23-27 & 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Degironimo et al (US Patent No. 4502488). Degironimo discloses an injection device which automatically refills a syringe, the method comprising sensing a volume of fluid in a chamber of the syringe, receiving a preset amount of fluid necessary for a subsequent injection from user input; comparing said volume in said chamber with said preset amount of fluid and retracting a plunger within said chamber of said syringe to a predetermined limit if said preset amount of fluid is greater than the volume of fluid sensed in said chamber, wherein predetermined limit maximally fills said chamber of said syringe, wherein the predetermined limit is less than a maximal volume of said chamber, and wherein the preset amount of fluid can be changed, see col. 2 line 10-15 & lines 39-54.

With respect to claim 26, wherein the reference discloses the step of purging air bubbles, see col. 5 line 66 – col. 6 line 7.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosenberg et al (US Patent No. 4596575) or Rubinstein (US Patent No. 3888239) in view of Reinicke (US Patent No. 4684365). Even though Rosenberg or Rubinstein do not explicitly state the step of purging air from the chamber of the syringe attention is directed to Reinicke. The Reinicke reference teaches the step of purging air from the chamber of the syringe col. 7 line 47-51. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to incorporate the air purging step of Reinicke into the method of Rosenberg or Rubinstein in order to provide a safer device and to allow for a faster refill.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Degironimo et al (US Patent No. 4502488) as applied to claim 23 and further in view of Rubinstein (US Patent No. 3888239). Now even though Degironimo does not explicitly disclose the injection of radiographic contrast material attention is directed to Rubinstein. The Rubenstein reference teaches the use of an injector that is capable of injecting multiple different materials including that of delivering contrast material in order

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to perform angiographic procedures. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to utilize the teachings of Rubinstein by utilizing the injector of Degironimo to deliver any fluid necessary for the procedure.

Response to Arguments

Applicant's arguments filed 12/11/06 have been fully considered but they are not persuasive.

Applicant argues that the references do not disclose receiving a preset amount of fluid necessary for a subsequent rejection from user input, the examiner disagrees. Due to the broad wording of the claims the term user input of the preset amount of fluid is seen to be a physical action of providing fluid which is indeed done in the references, it is suggested that the applicant amend the claims to show the step of data input corresponding to the preset amount of fluid.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin Huh whose telephone number is 571-272-8208. The examiner can normally be reached on M-F: 9:00 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on 571-272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BHH

BHH

KEVIN C. SIRMONS
SUPERVISORY PATENT EXAMINER

